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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,121

05/26/2006

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20435/0204125-US0

5497

7278 7590 12/30/2008

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EXAMINER

TEJANO, DWIGHT ALEX C

ART UNIT

PAPER NUMBER

4112

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,121	Applicant(s) SHIRAISHI ET AL.	
	Examiner Dwight Alex C. Tejano	Art Unit 4112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>30 Mar 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 20, 32 are objected to because of the following informalities:

- 20: "Further" is incorrectly spelled.
- 32: "Identification" is incorrectly spelled.

Additionally, the Applicant is requested to review the lengthy claims for additional informalities that may be present. Appropriate correction of all errors is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 10, 12 – 17, and 24 – 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Urabe, et al. (US 2002/0140978); hereafter referenced as “Urabe.”

Note 1: The claimed “virtual film” is interpreted as server storage/hard disk space specifically allocated for photos. As such, “virtual film” is read upon by “server,” “storage space,” or the like. Similarly, “photo genres” are read upon by some “album” or “category” within some photo server space, or any other logical division of photo grouping by content. These terms are thus used interchangeably by the Examiner.

Note 2: While most of the bases for rejection are based upon the second embodiment of Urabe, some do refer to the first embodiment, which is incorporated into the second embodiment by Urabe's admission in [0110]: “another embodiment of the image storage system *including* the image storing apparatus according to the present invention” (emphasis added.)

Note 3: Claims 2 – 8, 10, 12 – 14, and 17 are all ultimately dependent upon claim 1. Therefore, for the following rejections for the presently listed claims, while not

explicitly stated, it is assumed that all of the claim limitations present due to the dependency upon claim 1 are met. Any dependency to any other claim is not assumed and is explicitly stated where appropriate.

Regarding **claims 1 and 9**, Urabe discloses a method and system regarding an image storing apparatus. Specifically, Urabe discloses a digital camera (110) connected to a terminal ("personal computer," 180), which is connected via electronic communication line (through the internet, 114) to a remote server (190) [0111].

Furthermore, Urabe has disclosed that his server receives a request through the receiving device (965) [0122.] Further, the customer chooses to place the image in a shared image management server or in a private server (user marks if "sharing" ... is possible") [0084.] In the shared server, Fig. 11 shows that the server has the user select a category from a list of predetermined categories [0088], and then places images in the server based on those categories in the database [0084.] The "using of a specific virtual film among a plurality of virtual films" limitation is read upon by the practice of uploading the images to specific places in the server space and further into places defined by those predefined categories. Urabe also specifically discloses that the images are displayed on the display of the communication terminal unit ("displaying on the mobile terminal with camera") [0085.] As such, the "receiving a request step" to use a "virtual film among a plurality of types of virtual film" is disclosed by Urabe.

Urabe also discloses that his server allocates space on the server that is uniquely given to each customer (i.e., 50 MB of server space) [0123.] Furthermore,

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because Urabe discloses the specific allocation of 50 MB per customer, this also inherently contains a "limiting end" — that is, end-limited to 50 MB.

Urabe specifically discloses the storing of an image in the image storage server in ST1 of Fig. 10 [0068.] ST2 discloses the association step, which identifies the image with specific customer information [0071.] These read directly upon the claimed "receiving photo data based on identification information" step.

Finally, Urabe discloses an outputting step when the end of virtual film is reached ("exceed[s] the predetermined limit capacity") [0124.] At this time, images are appropriately moved to other media, and notifications are sent to the customer. This data – data relating to the specific customer's photos – constitute "photo data" and therefore read upon the claimed "photo data associated with said identification information."

Regarding **claim 2**, Urabe discloses the displaying of identification information in the point calculation step (ST9, Fig. 10.) The user is notified of his current point status [0080], which, as Urabe discloses, includes customer ID information [0092.]

Regarding **claims 3 and 5**, Urabe discloses the transmitting and displaying of a notification when the allocated space is used up ("send the information that the predetermined limit capacity will be exceeded to the customer-side personal computer") [0125.]

Regarding **claim 4**, Urabe discloses the transmitting of identification information to the server ("sends the image data and the unique [identification] information to the server") [0121.]

Regarding **claims 6 and 7**, Urabe, as mentioned above, divides either the shared or private server into categories ("genres") that are classified in advance for the user to select [0088] (61.)

Because the user selects the specific server and category to upload the photo, then it is inherent that the server must receive the request for using a specific server ("virtual film.")

Additionally, because the servers are further classified into categories, then it inherently follows that they are both "classified in advance" and "according to photo genre." Therefore, these practices read upon the limitations of both claims 6 and 7.

Regarding **claim 8**, Urabe discloses all of the limitations present in claim 7, as describe above. Furthermore, Urabe discloses that the categories are separated and differentiated by name, such as "celestial body," "travel," etc. (Fig. 5.) Any word or phrase is put together by a series of separate characters constitute a string – for example, a string of ones and zeroes constitutes a binary character string. In this case, Urabe shows that each category is named with text – that is, a String-type character string.

Additionally, as mentioned above, Urabe discloses that the user selects exactly which server and category he wishes to use [0084, 0088.] Because the server identifies each request with a specific user, then it inherently follows that the identification information is combined with the genre name in the request.

Therefore, Urabe discloses the identification information of virtual film including genre as a character string.

Regarding **claim 10**, Urabe discloses that the film end is regulated when the number of photos reaches a set number (“quantity of images recorded ... exceeded”) [0129.]

Regarding **claim 12**, Urabe discloses regulating the film end by a set interval of time (“the current date passed the predetermined date”) [0129.]

Regarding **claim 13**, Urabe discloses outputting photo data to an external storage medium (“the CPU moves one or a plurality of images recorded thereon to the record medium”) [0124.] Urabe discloses that “record medium” encompasses a writable CD-R, a photographic print, a memory card, a Zip disk, an MO Disk, etc., all of which reads upon “external storage medium” [0116, 0124.]

Regarding **claim 14**, Urabe discloses transmitting the output of photo data to a desired destination through the electronic communication line (“outputs to a delivery

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device an instruction to the deliver the record medium to the customer side based on the customer's request") [0134.] Because the record media described in the previous claim all require to be connected to the computer through some electronic communication line (IDE/USB cables, Ethernet, Wi-Fi, etc.), the delivery to a record medium based on a customer request reads upon the claimed "transmitting of photo data."

Claims 15 and 16 have no substantial differences in limitation from claims 1 and 9. They are thus interpreted and rejected for the same reasons as described in those aforementioned claims.

Regarding **claim 17**, Urabe discloses that multiple parties can access the shared image management database, as well as the categories and image IDs embedded therein [0084, 0085.] Separate parties can access the same image server, the same images, and can upload images to that server from their own separate computers. In other words, these separate terminals access the same uniquely identified shared server through a shared ID that identifies that server, which receives the photo data from any of those separate terminals. As such, this practice reads upon the claim limitations in the present claim.

Claims 24, 25, 36, 40, and 41 are inherent variations of the previous claims. They are interpreted and thus rejected for the same reasons as described previously.

Further, regarding the “means for film management,” Urabe discloses that his server contains an image management device (comprised of elements 53, 61, 62, 63, and 64.)

Additionally, regarding the “canceling of an allocation” is read upon by the analogous deletion of images as disclosed by Urabe. All files are contained within separate allocations of space – that is, “file 1” does not exist in the same allocated space as “file 2.” Therefore, when “file 1” is deleted, its allocated space is cancelled and reallocated with “free space.” In this case, when users delete their image files, the allocations created for those files are similarly freed up and canceled. Urabe discloses that, depending on lack of user intervention, an image ready to be allocated to the space is deleted to make the database more efficient [0137.] This practice is analogous to the “canceling of an allocation” and is, therefore, considered disclosed by Urabe.

As to **claims 26 - 29**, Urabe discloses all of the limitations of claim 24, as disclosed above. The further limitations of these claims are inherent variations of rejected claims 10, 12 – 14, respectively. Claims 26 – 29 are therefore interpreted and rejected for the same reasons presented in the previous rejections.

As to **claim 30**, Urabe discloses all of the limitations of claim 24, as disclosed above. Further, the additional limitations present are inherent variations of rejected claims 6 – 8. Claim 30 is therefore interpreted and rejected for the same reasons as presented in those previous rejections.

Claims 31 and 32 are interpreted and thus rejected for the same reasons as described in independent claims 1 and 9, with further limitations addressed.

Urabe discloses the displaying of identification information in the point calculation step (see claim 2.)

Further, Urabe discloses the “obtaining transmitted image information from the server side” [0121,] reading upon the “transmitting terminal-side identification information” of claim 32.

As to **claim 33**, Urabe discloses all of the limitations in claim 31, as discussed above. Further, the additional limitation present has already been addressed in the rejection of claim 9. As such, claim 33 is interpreted and rejected for the same reasons as presented in the previous rejection.

As to **claims 34 and 35**, Urabe meets all of the limitations present in claim 31, as discussed above. Further, the additional limitation has already been addressed in claim 3. As such, the present claim is interpreted and rejected for the same reasons presented in the previous claim rejection.

As to **claim 37**, Urabe meets all of the claim limitations present in claim 36, as discussed above. Additionally, in the same way that the server of claim 36 is an inherent variation of the methods presented in the independent method claims, the

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additional limitation present in the current claim is an inherent variation of the limitation present in claim 2. As such, claim 37 is interpreted and rejected for the same reasons as presented in the rejection to claim 2.

As to **claim 38**, Urabe meets all of the claim limitations present in claim 36, as presented previously. Further, similar to the previous rejection, the further limitation present in the current claim is an inherent variation of the limitation present in claim 6. As such, the present claim is interpreted and rejected for the same reasons as presented in the rejection to claim 6.

As to **claim 39**, Urabe discloses everything as claimed in claim 36, as disclosed above. Furthermore, similar to the previous rejections, the further limitation present in claim 39 is an inherent variation of the limitation present in claim 3. As such, the present claim is interpreted and rejected for the same reasons as presented in the rejection to claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urabe.

Regarding **claim 11**, Urabe meets all of the limitations of claim 10, as described in the previous section. Further, Urabe discloses that, when the user is nearing the end of the allocated space, a message is sent to notify that the remaining capacity is within a set number (i.e., 10 MB) [0127.] Because Urabe discloses this as a practice based on how much hard disk space is left and because Urabe discloses that the space can be regulated by a set quantity (see claim 10), it would be a simple task to adapt such a practice to also be used dependent on how many photos are left. Therefore, it would be obvious to one of ordinary skill in the art to display the number of photos remaining because it is a way to notify the user of how much space is left when the different space evaluation method is used.

Claims 18 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urabe in view of Katagishi, et al. (US 2003/0120745); hereafter referenced as “Katagishi.”

Regarding **claim 18**, Urabe discloses the limitations present in claim 15, as disclosed in the previous section. However, Urabe fails to disclose the use of a client device to aid in server access. Despite this, the Examiner maintains that it was well known in the art to use a client device in this way, as shown by Katagishi.

In a related art regarding product information distribution over a network, Kupka discloses the use of a client device (“RFID” or “information transmitter”) that is connected to an electronic communication line (“wireless telecom network.”)

Katagishi discloses that the information transmitter returns a server access address [0019.] Katagishi further discloses the device will notify said address to mobile terminal (“extracting site access address”) and use it for server access (Fig. 15, S4/S5.)

Katagishi notes that the main function of his system is to control electronic information distribution, and that the RFID tags are useful in providing URLs [0010] and in automatically acquiring information from a server [0015.] Urabe notes that his system connects to a specific remote storage space in order to store or to distribute photos.

Therefore, it would be obvious to one of ordinary skill in the art to combine the two arts, as adding a client device containing the IP address or URL of the server in Urabe’s system would allow the user to connect to the system and to validate his identity at any computer or terminal connectible to the client device. The combination

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also adds security to the system, preventing unauthorized access to the server by ensuring that only the client device holder can access the storage space set aside for the user.

Regarding **claim 19**, the combination of Urabe and Katagishi discloses everything in claim 18, as described above. Katagishi discloses including client specifying information relating to the client device ("accessible user personal information") (Fig. 14, S31/S32)

Urabe discloses the practice of sending unique ID information to the storage server in order to determine the user and allocate the proper space for that user. As stated previously, connecting a client device to Urabe's system is obvious because it would allow one to connect securely at any terminal connected to the device. In the same vein, including client specifying information in the client device would be obvious to one of ordinary skill in the art, as it adds another layer of security to the system. If the client information is contained only in the client device, then there would be no risk in connecting to public/unsecured terminals, as no actual login information would be entered into them.

Regarding **claim 20**, the combination of Urabe and Katagishi discloses everything in claim 18. Furthermore, Katagishi discloses that the client device transmits supporting information necessary for the user in the communication with the server. Specifically, Katagishi mentions that product information, supplier information, etc. is

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transmitted by the server defined by the address given in the information transmitter [0018.]

Because “supporting data” is broad, this is reasonably interpreted as any data transmitted from the terminal to the server. As such, it would be reasonable to surmise that any data supporting the more efficient processing (“usage request”) of Urabe’s system would be obvious to include in the client device.

Limit capacity data, available recordable media options, and even physical server location data are all legitimately acceptable under “supporting data.” The limit capacity data will better allow the user to micromanage the available storage space, and the available recordable options will help the user more easily decide to what medium he would like his prints. The physical server location data will help the user determine to where he would like to upload his photos, as closer servers will always have better transfer speeds than those much farther away.

As such, it would be obvious to one of ordinary skill in the art to use Katagishi’s practice of sending additional information with Urabe, as all of them can be used to more efficiently run Urabe’s system.

Regarding **claims 21 and 22**, the combination provided by Urabe and Katagishi meets all of the limitations of claim 18. Moreover, Urabe further discloses that notifications are sent via e-mail when requesting image information [0074.] Further, the customer ID information contains addresses that are previously registered with the system in Urabe (Fig. 7, “address.”)

Firstly, while not explicitly stated, it would be obvious that the customer ID information contains an e-mail address. Even though Fig. 7 lists only a generic "address," notifications cannot be sent via e-mail unless the system has record of that specific customer's e-mail address. Additionally, if the ID information contains one e-mail address, it would be an obvious practice to allow the ID information to contain multiple e-mail addresses that are registered by the user because it would be a way to prevent the non-receipt of a message – that is, as the user nears the end of his allocation, he may want to select multiple e-mail addresses to receive notifications in order to ensure prompt receipt of that notification.

Considering this, it would be obvious to one of ordinary skill in the art to send a notification from the client device to the mobile terminal with respect to e-mail addresses previously registered in the device.

As previously mentioned in the rejection to claim 19, it would be obvious to place the customer ID information on the client device ("information transmitter") because it adds additional layers of security to the system that would prevent unauthorized access to the user's personal account. Because "notification of address specifying information ... with respect to e-mail addresses" is so vague, the act of sending notification data based on the customer's e-mail address(es) included with the ID information on the client device through Urabe's system of notification via e-mail reads upon the claim.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urabe in view of Kaminkow, et al. (US 2003/0036425); hereafter referenced as “Kaminkow.”

Regarding **claim 23**, Urabe meets all of the limitations present in claim 15, as disclosed above. However, Urabe fails to disclose the holding, evaluating, or processing of prize specifying information. Despite this, the Examiner maintains that it was well known in the art to hold, evaluate, or process prize information, as disclosed by Kaminkow.

Kaminkow discusses a “loyalty points program” that contains:

- a server holding advance prize specifying information (200, “loyalty point instrument server”)
- an evaluation step (517, prize request step) determining whether or not data relating to said prize specifying information is included
- a processing step (535, issue prize step) that processes and issues a corresponding prize.

Regarding the evaluation step, it is inherent that if a prize is requested (517) and subsequently allowed (520) or denied (518) that an evaluating the inclusion of data relating to prize specifying information must have occurred. After all, if a prize is requested and allowed, then the system must have evaluated data relating to prize specifying information in order to “display a prize menu” (520.)

Furthermore, in a similar vein, Urabe discusses the use of “points” and its accumulation in order to track usage or price [0080, 0081.]

As such, it would be obvious to one of ordinary skill in the art to combine Kaminkow’s loyalty points program with the points aspect of Urabe’s system, as instituting a loyalty points program would give any vendor of Urabe’s system the same marketing benefits as disclosed in Kaminkow, such as continuous sustained use [0006.]

Citation of Pertinent Art

The prior art made of record is considered pertinent to the applicant’s disclosure, but is not relied upon as a reference for the preceding sections:

- Paul, et al. (US 7,305,233) teaches a method and apparatus for controlling the distribution of digital images on a remote server.
- Anderson, et al. (US 7,117,519) teaches a method and system for allowing a user to select server actions when uploading images from a camera.
- Prust (US 2005/0278422) teaches a multi-user remote data storage network with unique user identification information.
- Miyazaki (US 2005/0206749) teaches a cellular telephone with a digital camera that can store an image to a remote storage location.
- Nakai, et al. (US 2004/0003411) teaches an image service system wherein an imaging unit uploads a plurality of images to selected remote terminals.
- Safai (US 6,715,003) teaches a photo service provider that manages developing, printing, and delivery of photographic prints of digital images.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwight Alex C. Tejano whose telephone number is (571) 270-7200. The examiner can normally be reached on Monday through Friday 9:30-6:00 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jefferey F. Harold can be reached on (571) 272-7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dwight Alex C Tejano
Examiner
Art Unit 4112

/Dwight Alex C Tejano/
/Jefferey F Harold/
Supervisory Patent Examiner, Art Unit 4112